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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/648,215	08/27/2003	Iain MacKay	NIDI-011	4334

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EXAMINER
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GARCIA, ERNESTO

ART UNIT	PAPER NUMBER
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3679

DATE MAILED: 12/22/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

10/648,215

Applicant(s)

MACKAY, IAIN

Examiner

Ernesto Garcia

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3679

MW

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
  - If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
  - If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
  - Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 27 August 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-7 is/are pending in the application.
- 4a) Of the above claim(s) 5-7 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-4 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 27 August 2003 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- ☒ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date 8/27/03.
- ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: \_\_\_\_\_.

## DETAILED ACTION

### *Election*

This application contains claims directed to the following patentably distinct species of the claimed invention:

- I. Figs. 1-5.            II. Figs. 1 and 6            III. Figs. 1 and 7

Figure 1 is generic to all species.

Applicant is required under 35 U.S.C. 121 to elect a single disclosed species for prosecution on the merits to which the claims shall be restricted if no generic claim is finally held to be allowable. Currently, claim 1 is generic.

Applicant is advised that a reply to this requirement must include an identification of the species that is elected consonant with this requirement, and a listing of all claims readable thereon, including any claims subsequently added. An argument that a claim is allowable or that all claims are generic is considered nonresponsive unless accompanied by an election.

Upon the allowance of a generic claim, applicant will be entitled to consideration of claims to additional species which are written in dependent form or otherwise include all the limitations of an allowed generic claim as provided by 37 CFR 1.141. If claims are added after the election, applicant must indicate which are readable upon the elected species. MPEP § 809.02(a).

Should applicant traverse on the ground that the species are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the species to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the inventions unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. 103(a) of the other invention.

During a telephone conversation with Mr. Trevor C. Klotz on December 13, 2004, a provisional election was made with oral traverse to prosecute the invention of species II. Applicant in replying to this Office action must make affirmation of this election. Claims 1-4 are considered to be readable on the elected species. With respect to claims 5-7, these claims are not readable on the elected species and are withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention because claim 5 does not read on the elected species as the collar 49 does not abut the top portion of the lower support rail and claim 6 does not read on

species II as the elected picket only has one recess in one of the sidewalls. Regarding claim 7, this claim is directed to species III.

### ***Drawings***

The drawings are objected to as failing to comply with 37 CFR 1.84(p)(4) because reference character "80" has been used to designate a bar with a long tab 82 (Figs. 2, 3 and 5), a bar with a short tab (Fig. 6), and a bar with a keyhole (Fig. 7).

The drawings are objected to as failing to comply with 37 CFR 1.84(p)(4) because reference character "47" has been used to designate both a picket with two through recesses 60, 61 (Fig. 2,3 and 5) and a picket with one recess (Fig. 6).

The drawings are objected to as failing to comply with 37 CFR 1.84(p)(4) because reference character "82" has been used to designate both a long tab (Fig. 5) and short tab (Fig. 6).

Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The replacement sheet(s) should be labeled "Replacement Sheet" in the page header (as per 37 CFR

1.84(c)) so as not to obstruct any portion of the drawing figures. If the examiner does not accept the changes, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

### ***Claim Objections***

Claims 1, 2 and 4 are objected to because of the following informalities:

regarding claim 1, "a" in line 8 needs to be deleted, --a-- needs to be inserted before "uniformly" in line 9 and "recesses" in line 10 needs to be --recess-- as each picket has one uniformly oriented rail connecting recess in at least one sidewall; "corresponding" in line 14 should be --the--, "recesses" in line 14 should be --recess--, "a" in line 15 needs to be deleted, "the" in line 16 needs to be deleted, "respective ones of" in line 17 needs to be deleted, "corresponding ones of" in lines 18 and 21 need to be deleted, "are" in line 20 should be --is--, the period in line 20 needs to be deleted, and "recesses" in line 21 needs to be --recess--;

regarding claim 2, "it" in line 1 needs to be deleted;

regarding claim 3, "the" in line 2 should be --having-- and "recesses" in line 3 should be --apertures--; and,

regarding claim 4, "sidewalls" in line 1 should be --sidewall-- as at least one sidewall has been previously recited. Appropriate correction is required.

***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

DPS      1-4  
Claims ~~1-6~~<sup>1-4</sup> are rejected under 35 U.S.C. 112, second paragraph, as being

indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Regarding claim 1, the limitation "said at least one support rail" in line 13 makes the claim unclear as two support rails were previously recited. Furthermore, the limitation "said support rail" in lines 16-17 makes unclear whether the support rail is the lower support rail or the upper support rail. Moreover, it is unclear whether applicant is positively claiming the projecting flange in line 20. For purposes of examination, the examiner has consider the projecting flange positively claimed.

Regarding claims 2-4, the claims depend from claim 1 and therefore are indefinite.

***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-3 are rejected under 35 U.S.C. 102(b) as being anticipated by Canda, 1,109,613 (see marked-up attachment).

Regarding claim 1, Canda discloses, in Figures 1, a metal picket fence or gate panel assembly comprising an upper support rail **A1**, a lower support rail **A2**, a horizontal row of vertically disposed elongate pickets **1**, and a fastening means **2b**. The upper support rail **A1** and the lower support rail **A2** are spaced apart and vertically aligned. The upper support rail **A1** and the lower support rail **A2** are each defined by an inverted U-shaped channel (Fig. 4) having an elongate top portion **A4** and spaced apart picket receiving apertures **3a** extending therethrough. The pickets **1** respectively extend through vertically aligned pairs of the picket receiving apertures **3a** in the upper support rail **A1** and the lower support rail **A2**. The pickets **1** each have a uniformly oriented rail connecting recess **5a** in at least one sidewall **1d** thereof and at locations there along corresponding to a relative positioning of the upper support rail **A1** or the lower support rail **A2**. The fastening means **2b** is for positively connecting the upper support rail **A1** or the lower support rail **A2** to the recess **5a** in the pickets **1**. The fastening means **2b** comprises an elongate bar **2b** having spaced bar apertures **4a** extending therethrough. The bar **2b** is slidably disposed within the upper support rail **A1** or the lower support rail **A2**. An inwardly projecting flange **A12** in the bar apertures **4a** is received in the recess **5a**.



Regarding claim 2, the upper support rail **A1** and the lower support rail **A2** are identical and parallel to one another. The pickets **1** are identical. The fastening means **2b** is slidingly disposed in at least the upper support rail **A1**.

Regarding claim 3, the bar apertures **4a** each include a first open portion **A13** and a second open portion **A14**. The first open portion **A13** has dimensions of which at least correspond to the dimensions of the picket receiving apertures **3a**. The second open portion **A14** includes the projecting flange **A12**.

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claim 4 is rejected under 35 U.S.C. 103(a) as being unpatentable over Canda, 1,109,613, in view of Hebda, 4,883,256.

Regarding claim 4, Canda, as discussed above, fails to disclose the sidewall **1d** of each of the pickets **1** including a surrounding collar. Hebda teaches, in Figure 6, a

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sidewall of each picket 14 including a surrounding collar 15 to provide a decorative look to the pickets. Therefore, as taught by Hebda, it would have been obvious to one of ordinary skill in the art at the time the invention was made to include a collar on the sidewall of each picket to decorate the pickets. Applicant is reminded that the location of the upper support rail **A1** relative to the recess **5a** is determined when the collar 15 abuts the top portion **A4** of the upper support rail **A1**.

### ***Conclusion***

The following prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Constance Jr. et al., 2,771,276, and Spath, 1,850,779 show a similar metal picket or gate panel assembly.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ernesto Garcia whose telephone number is 703-308-8606. The examiner can normally be reached from 9:30-6:00. The fax phone numbers for the organization where this application or proceeding is assigned are 703-872-9326 for regular communications and 703-872-9327 for After Final communications.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Daniel P. Stodola can be reached on 703-308-2686. Any inquiry of a

general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-1113.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

E.I.



E.G.

December 15, 2004

Attachment: one marked-up copy of Canda, 1,109,613.

DANIEL P. STODOLA  
SUPERVISORY PATENT EXAMINER  
TECHNOLOGY CENTER 3600

(Canda) 1,109,613

